

**RECEIVED
CENTRAL FAX CENTER**

JAN 19 2005

60137-162

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Katsamberis
Serial No.: 09/747,250
Filed: December 21, 2000
Group Art Unit: 1775
Examiner: Piziali, Andrew T.
Title: COATED ARTICLE WITH POLYMERIC BASECOAT

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

Subsequent to the filing of the Notice of Appeal on November 19, 2004, Appellant hereby submits its brief. Appellant already paid the appeal brief fee with the Appeal Brief filed April 28, 2003. If any additional fees are due, the Commissioner is authorized to charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds, P.C. for any additional fees or credit the account for any overpayment.

REAL PARTY IN INTEREST

The real party in interest is Masco Corporation, the assignee of the entire right and interest in this Application.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 8, 22-32 and 34 stand finally rejected under 103(a), Claims 5-7 and 12-15 have been cancelled, and claims 1-4, 9-11, 16-21 and 33 stand withdrawn from consideration.

60137-162

STATUS OF AMENDMENTS

All amendments have been entered.

SUMMARY OF THE INVENTION

As shown in Figure 1, this invention relates to a multi-layer coating on an article 12. The multi-layer coating includes a polymer layer 13 on the surface of the article 12 (page 3, last paragraph). A color and protective layer 32 on the polymer layer 13 is comprised of a refractory metal compound or a refractory metal alloy compound (page 7, last paragraph). The coating further includes a layer 34 comprised of the refractory products of (i) refractory metal or refractory metal alloy, (ii) oxygen and (iii) nitrogen on the layer comprised of refractory metal compound or refractory metal alloy compound 32 (page 11, second paragraph). This basic structure is set forth in claim 8.

Claim 25 depends on claim 8 and adds that the polymer layer 13 is epoxy urethane (page 3, last line). Claim 28 depends on claim 8 and adds that the color and protective layer 32 provides one of a gold color, a brass color, or nickel color (page 8, first full paragraph). Claim 29 depends on claim 8 and adds that the color and protective layer 32 provides a nickel color (page 8, first full paragraph).

ISSUES

- A. Are Claims 8, 22-24, 26-28, 30-32 and 34 properly rejected under 35 U.S.C. 103(a) based on Welty (U.S. Patent No. 6,132,889) in view of Simmons (U.S. Patent No. 6,154,311)?
- B. Is Claims 25 properly rejected under 35 U.S.C. 103(a) based on Welty in view of Simmons and Dewey (U.S. Patent No. 4,143,009)?
- C. Are Claims 28 and 29 properly rejected under 35 U.S.C. 103(a) based on Welty in view of Simmons and Meckel (U.S. Patent No. 6,196,936)?

60137-162

PATENTABILITY ARGUMENTS**A. The rejection of Claims 8, 22-24, 26-28, 30-32 and 34 under 35 U.S.C. 103(a) is improper.**

The Examiner finally rejected Claims 8, 22-24, 26-28, 30-32 and 34 under 35 U.S.C. §103(a) as being obvious over Welty in view of Simmons. Welty teaches a coated article including a nickel layer applied on a substrate 12. A nickel layer 13 is applied on the substrate 12, and a layer 22 of a refractory metal or refractory metal alloy is disposed over the nickel layer 13. The nickel layer 13 provides improved corrosion protection to the underlying substrate 12 (column 3, lines 11 to 22). A layer 32 of refractory metal compound or refractory metal alloy compound is vapor deposited over the layer 22. Finally, a layer 34 of the reaction products of refractory metal or refractory metal alloy, oxygen and nitrogen is deposited over the layer 32. The Examiner admits that Welty does not disclose any layer of polymer. The Examiner states that Simmons discloses a photocatalytic dielectric combiner element 30 layered on a hard polymer 32. The Examiner contends that it would be obvious to employ a polymer layer in place of the nickel layer 13 in Welty because of Simmons. Appellant respectfully disagrees.

The present invention is patentable and strikingly different from the combination of Welty and Simmons. As described by the claims, the present invention provides an article having on at least a portion of a surface a multi-layer coating including a layer comprised of polymer on the surface of the article, a color and protective layer comprised of refractory metal compound or refractory metal alloy compound on the layer comprised of polymer, and a layer comprised of the reaction products of (i) refractory metal or refractory metal alloy, (ii) oxygen and (iii) nitrogen on the layer comprised of refractory metal compound or refractory metal alloy compound. [See Claim 8]. Claims 8, 22-32 and 34 of the present invention all share this same or similar feature. [See Claims 8, 22-32 and 34]. It is not obvious to replace the nickel layer 13 of Welty with a polymer layer because of Simmons.

First, Simmons is non-analogous art to both Appellant's invention and to Welty and is not reasonably pertinent to Appellant's particular problem. "In order to rely on a reference as a basis for rejection of an Appellant's invention, the reference must either be in the field of Appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was

60137-162
concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The Simmons reference is not analogous art to Welty or to Appellant's invention.

The Simmons reference is not in Welty or Appellant's field. Welty is directed to a decorative coating that provides abrasion protection, corrosion protection, and chemical resistance. Appellant's invention is directed toward a coated article having a decorative and protective coating. Simmons is directed to an ultraviolet reflective photo catalytic dielectric combiner that oxidizes bacteria and contaminants to provide a self-cleaning, self-sanitizing, and self-deodorizing surface. In Simmons, ultraviolet light initiates a photo catalytic reaction at a titanium dioxide surface to provide a surface that kills bacteria and contaminants. This is far removed from Welty and Appellant's invention which are directed to protective and decorative coatings that provide abrasion and corrosion resistance. That is, Simmons's field relates to a self-cleaning surface to kill bacteria and contaminants, while Welty and Appellant's field concern decorative and protective coatings. These fields are very different from each other. Additionally, each of these fields has specific and unique design criteria and component characteristics which are not compatible with each other. One skilled in the art seeking to modify a decorative and protective coating would not consider the self-sanitizing surface of Simmons.

Additionally, Simmons is not reasonably pertinent to Appellant's particular problem. A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. In re Clay, 966 F. 2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). As discussed above, Simmons is clearly not within the field of decorative and protective coatings, which is the subject to which Appellant's invention is directed. A protective and decorative coating provides a desired appearance and also helps to provide corrosion and abrasion resistance. A self-sanitizing surface is used to kill bacteria and contaminants. Because Simmons relates to a self-cleaning surface, Simmons does not logically commend itself to the attention of an inventor seeking to solve problems present in decorating and protective coatings that prevent abrasion. Simmons is not reasonably pertinent to Appellant's particular problem.

Moreover, even considering, arguendo, Simmons to be analogous art, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art

60137-162

suggests the desirability of doing so. There simply is no teaching, suggestion, or incentive in either of the applied references that would have led one of ordinary skill in the art to modify the Welty coating in the manner proposed by the examiner.

The examiner argues that it would have been obvious to one having ordinary skill in the art to provide the coating of Welty "with a polymer layer, as taught by Simmons Jr., because the polymer layer provides a viable alternative to electroplating in addition to providing corrosion resistance while leveling a substrate by forming a smooth hard surface." This is clearly a use of hindsight reconstruction. It is impermissible to engage in hindsight reconstruction of the claimed invention, using the Appellant's structure as a template and selecting elements from the references to fill the gaps. The references themselves must provide some teaching whereby the Appellant's combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18USPO2d 1885, 1888 (Fed. Cir. 1991). There simply is no suggestion in the references, or in the prior art as a whole, that suggests the desirability of making the combination.

The examiner seeks to modify the coating of Welty to include the polymer layer of Simmons. First, assuming the examiner is arguing that the coating is modified to include a polymer layer, there would be no reason to modify Welty to include a polymer layer. Welty already has an electroplated nickel layer. The nickel layer provides a plating surface. To add a polymer layer would unnecessarily increase costs and make the coating more difficult to form.

If, on the other hand, the examiner is arguing that the coating of Welty is modified to replace the nickel layer with the polymer layer, there also is no suggestion to make this modification. It is impermissible to modify a base reference in a manner that defeats the benefits achieved by the teachings of the reference. Welty teaches that the nickel layer provides corrosion resistance and acts as a leveling layer to cover or fill imperfections in the substrate. To eliminate the nickel layer and replace the nickel layer with a polymer layer would defeat the benefits achieved by Welty. There is no support in Simmons that indicates the use of the polymer layer would satisfy all of the problems solved by using the nickel layer of Welty or that indicates the polymer layer performs in any way better than the structure already provided by Welty.

The examiner has pointed to no teaching in Simmons of any particular benefit to be derived from using the polymer layer instead of the nickel layer. Further, there is nothing in Welty that

60137-162

would have led one of ordinary skill in the art to believe that Welty's nickel layer was in any way deficient for Welty's purposes or was in need of modification. One of ordinary skill in the art would have found no reason, suggestion, or incentive for attempting to combine these references other than through the luxury of hindsight accorded one who first viewed Appellant's disclosure. This is not a proper basis for a rejection under 35 U.S.C. 103(a).

Additionally, Simmons does not teach replacing a nickel layer with a polymer layer as suggested by the Examiner. Simmons teaches that a copper layer can be replaced with a polymer layer (column 6, lines 39 to 44). Simmons additionally teaches that a nickel layer can be added to the copper layer. However, in Simmons, the polymer layer replaces a copper layer or a combined copper layer and nickel layer (column 6, lines 39-45). That is, the polymer layer of Simmons does not replace a nickel layer. Simmons does not teach replacing a nickel layer with a polymer layer, and therefore, the combination of the references does not teach, suggest or disclose the claimed invention. Therefore, when Welty and Simmons are combined, the combination does not teach, suggest or disclose the claimed invention.

Providing a polymer layer also provides many benefits and solves the problems of the prior art. The polymer layer claimed by Appellant provides many additional benefits and advantages over the prior art nickel layer. As disclosed on page 2 of Appellant's specification, a drawback to the nickel layer of the prior art is that the nickel layer must be electroplated when applied to the substrate. Welty discloses (column 2, lines 29 to 33) that the nickel layer 13 can be deposited on the surface of the substrate 12 by a plating process, such as electroplating. Electroplating the nickel layer requires electroplating equipment, which is expensive. The electroplating process is also laborious and time consuming. The polymer layer of Appellant's claims eliminates the problems of the prior art as electroplating is not necessary. Appellant's claims are not obvious, and Appellant respectfully requests that the rejection be withdrawn.

B. The rejection of Claim 25 under 35 U.S.C. 103(a) is improper.

The Examiner further rejected claim 25 under 35 U.S.C. §103(a) as being unpatentable over Welty in view of Simmons and Dewey. The Examiner asserts that Dewey teaches the use of an

60137-162

epoxy urethane, and claim 9 is obvious in view of the combination of Welty, Simmons and Dewey. Appellant respectfully disagrees.

Claim 25 is not obvious in view of the combination of Welty, Simmons and Dewey. The Dewey reference is not in Welty or Appellant's field and is not reasonably pertinent to the particular problem that Appellant has solved. Welty is directed to a coating for a faucet or a door knob that is decorative and provides abrasion protection, corrosion protection, and chemical resistance. There is no suggestion to use epoxy urethane in the combination of Welty and Simmons. Appellant's invention is directed toward a coated faucet or door knob having a decorative and protective coating. Dewey teaches an epoxy urethane material, but focuses on the chemistry and the method of making the epoxy urethane. Dewey does not teach, suggest or disclose using epoxy urethane as a coating that is decorative and protects. The epoxy urethane of Dewey does not logically comment itself to the attention of an inventor seeking to solve problems in decorative and protective coatings. The combination of Welty, Simmons and Dewey does not disclose or suggest claim 25, and Appellant respectfully requests that the rejection be withdrawn.

C. The rejection of Claims 28 and 29 under 35 U.S.C. 103(a) is improper.

The Examiner further objected to claims 28 and 29 under 35 U.S.C. §103(a) as being unpatentable over Welty in view of Simmons and Meckel. The Examiner asserts that Meckel teaches a silver or lustrous gray color, which the Examiner is interpreting as equivalent to nickel. The Examiner argues it would be obvious to use the refractory metal compounds or refractory metal alloy compounds of Meckel as the color and protective layer of Welty to provide a nickel color, and therefore Claim 28 and 29 are obvious. Appellant respectfully disagrees.

Claim 28 and 29 are not obvious in view of the combination of Welty, Simmons and Meckel. The Meckel reference is not in Welty or Appellant's field and is not reasonably pertinent to the particular problem that Appellant has solved. Welty and Appellant's invention are directed to a coating for a faucet or a door knob that is decorative and provides abrasion protection, corrosion protection, and chemical resistance. Meckel is directed to a coating for a golf club. Thus, Meckel's field is related to golf clubs, while Welty and Appellant's field concern faucets and door knobs. These fields are very different from each other. Further, each of these fields has specific and unique

design criteria and component characteristics, which are not compatible with each other. Claims 28 and 29 are not obvious, and Appellant respectfully requests that the rejection be withdrawn. 60137-162

CLOSING

For the reasons set forth above, the rejection of all claims is improper and should be reversed. Appellant respectfully requests such an action.

Respectfully Submitted,

CARLSON, GASKEY & OLDS, P.C.

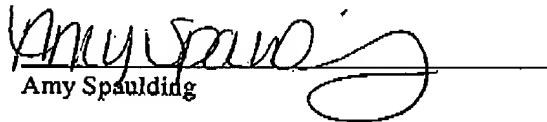


Karin H. Butchko
Registration No. 45,864
Attorney for Appellant
400 West Maple Road, Suite 350
Birmingham, Michigan 48009
(248) 988-8360

Dated: January 19, 2005

CERTIFICATE OF FACSIMILE

I hereby certify that this appeal brief is being facsimile transmitted to the United States Patent and Trademark Office, (703) 872-9306 on January 19, 2005.



Amy Spaulding